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IN THE

Supreme Court of the United States

OCTOBER TERM, 1959

No. 940

CRANE PACKING COMPANY, et al.,
Petitioners,

vs.

SPITFIRE TOOL & MACHINE CO., INC.,
Respondent.

MOTION UNDER RULE 42-1
and
BRIEF, AMICUS CURIAE, IN SUPPORT OF PETITION FOR CERTIORARI

AMERICAN PATENT LAW ASSOCIATION
JAMES P. HUME
38 S. Dearborn
Chicago 3, Illinois
ROBERT C. BROWN, JR.
GEORGE E. FROST
Its Attorneys

Chicago, Illinois
June 1, 1960

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Now comes the American Patent Law Association and prays that leave be granted to file the accompanying brief *amicus curiae*. Movant is a membership association of substantially 2200 lawyers, most of whom specialize in patent law. This motion is presented because of the public importance of the question presented as to the construction of the statutes relating to reissue patent applications (First question presented, Petition, p. 2).

Respondent has refused to consent to the filing of a brief *amicus curiae* by Movant. Petitioners have assented.

Respectfully submitted,

American Patent Law Association
JAMES P. HUME
ROBERT C. BROWN, JR.
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Its Attorneys

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I.

The court below has held that:

> "• • • The District Court did not err in holding §102(b) applicable and that claims 11 to 14, inclusive, were invalid because of public use and sale of Bullard's commercial device more than one year prior to the application for the reissue patent. • • •" (Petition, Appendix B, p. 43)

The court further noted that Section 102(b) of the 1952 Patent Code (35 U.S.C.):

> "• • • requires denial of an application for patent if 'the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.'" (Petition, Appendix B, p. 43)

If the court below is correct, any new claim in a reissue patent application filed more than one year after issuance of the original patent (and hence publication) is necessarily invalid and void.

II.

This novel statutory interpretation raises issues of substantial public importance. Some 1200 reissue patents have issued under the 1952 Patent Code. Over 40 percent of these patents (about 500) are rendered invalid by the rule applied below because they contain new claims and were filed more than a year after issuance of the original patent. An undeterminable additional number, perhaps 500, are invalid under the rule applied below because they contain new claims and were filed more than one year after public use of the subject matter covered.

Equal public importance attaches to the treatment of existing and future applications for reissue patent. The Patent Office practice, both before and after the 1952 Patent Code, is expressed in Section 1401.09 of the official Manual of Patent Examining Procedure, namely that:

> "To be effective, a reference must be prior to the effective filing date of the original patent."

This is equivalent to stating that Section 102(b) applies only with reference to the filing date of the original patent application. It is contrary to the rule applied below in the present case. The Office rigidly demands compliance with the reissue statutes, but it has never considered the passage of a single year after the original grant to be fatal to new claims in a reissue (See, *e.g. Ex parte Brownlee*, 122 USPQ 287).

The Patent Office now faces a dilemma. If it follows the rule applied below, it must reject all new claims in reissue

applications filed more than one year after the original grant. But in so doing it will deprive applicants of the benefits of a long and previously uniform line of decisions, the prior uniform administrative practice, and the uniform understanding that the 1952 Patent Code did not change the law in this respect. But if the Patent Office continues its present practice it ignores the plain dictate of the decision below. Under all of the circumstances refusal by the Patent office to follow the decision below appears to be an administrative necessity. No matter what it does, however, the Patent office must make an undesirable compromise on a matter that can now only be resolved by decision of this Court.

III.

The decision below conflicts in principle with the decisions of other courts of appeal. In *Rohm & Haas Co.* v. *Roberts Chemicals,* 245 F. (2d) 693 (4th Circuit 1957) there was both a delay of some nine years after the original grant and more than one year of public use prior to the reissue application. The reissue patent with new claims was nevertheless held valid and infringed. The Court of Appeals for the Seventh Circuit itself sustained a reissue patent with new claims on similar facts in *Weller Mfg. Co.* v. *Wen Products, Inc.,* 231 F. (2d) 795. A reissue patent with new claims was sustained in *Southern Saw Service* v. *Pittsburgh-Erie Saw Corp.,* 239 F. (2d) 339 (5th Cir. 1957) on a record showing public use more than one year prior to the reissue application, and in *Moist Cold Refrigerator Co.* v. *Lou Johnson,* 217 F. (2d) 39 (9th Cir. 1954) the court refused to hold a reissue with new claims invalid as a matter of law even though filed 12 years after the original grant.

IV.

The decision below is believed to be an erroneous construction of the reissue statutes.* The last paragraph of Section 251 of Title 35 alone demonstrates that the Congress did not intend the result reached below. This paragraph reads:

> "No reissue patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent."

This language plainly contemplates that an "enlarging" reissue (which necessarily carries new claims) can issue, say, on an application filed 18 months after issuance of the original patent. It also contemplates that other reissue patents may issue on applications filed more than two years after issuance of the original patent.

But this can never be if—as the court below held—Section 102(b) applies as of the application date of a reissue. When the original patent issues, it is printed and published by the Patent Office on the date of issuance. The original patent is thus necessarily a "printed publication" as of the issue date. Any reissue application with new claims filed more than one year thereafter would be barred, if Section 102(b) applies as of the reissue application date. There could be no such thing as an enlarging reissue application 18 months or two years after the date of the original patent.

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* No position is here taken on the second question presented by the petition for certiorari (Pet'n. p. 2). It is thought, however, that whether or not the patent is invalid on other grounds does not detract from the necessity of resolving the first question presented.

Moreover, Section 4(a) of the Patent Act of 1952 (66 Stat. 792) states that the Act "shall apply to unexpired patents granted prior to" the effective date of the Act. The Congress was here plainly proceeding on the basis that the Act would not have the effect of wiping out rights in existing reissue patents. Indeed, in view of this provision, the construction placed upon the Act by the court below raises grave constitutional questions. What the Congress intended, and what the court below should have held, was that the reissue provisions of the 1952 Patent Code followed the prior law of measuring prior art in a reissue application with reference to the original application filing date.

V.

The court below was apparently drawn to its erroneous conclusion by the expression of Section 251 that "The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent". Consideration of the Act as a whole demonstrates that Congress did not intend Section 102(b) (part of Chapter 10, entitled "Patentability of Inventions") to be read into Section 251.

Title 35 is divided into 29 "Chapters". Chapter 11, entitled "Application for Patent" includes the provisions relating to applications. It is to this chapter that Section 251 is intended to refer. The only purpose of reference to the "provisions of this title relating to applications" in Section 251 was to render unnecessary a new recitation of these procedural requirements.

As if to emphasize the above, the reference of Section 251 to "provisions of this title relating to applications" includes the clause "except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent." This is a clear allusion to the requirement of Chapter 11, Section 111,

that "The application must be signed by the applicant * * *". It stands as a specific indication that Section 251 refers to Chapter 11 and not to Section 102(b), which is entitled "Conditions for Patentability; Novelty and Loss of Right to Patent" and is in Chapter 10, entitled "Patentability of Inventions".

Had the Congress intended to read Section 102(b) into Section 251, it surely would have specifically stated that the statutory provisions relating to "Patentability" (Chapter 10) applied. It would not have mentioned "applications", which constitute the subject of Chapter 11. This is particularly true in view of the fundamental change in the substantive law associated with reading Section 102(b) into Section 251.

* * *

The judgment below is based on an interpretation of the law as to reissue patents that is contrary in principle to the decisions of other courts of appeal and of the Court of Appeals for the Seventh Circuit itself, it jeopardizes important rights in a large number of existing reissue patents, it casts a cloud over existing and future reissue patent applications, and it places upon the Patent Office an administrative dilemma requiring it to resolve a conflict in principle between the courts of appeal. The public importance of the first question presented on the petition, and the error committed below, dictate issuance of the writ.

Respectfully submitted,

American Patent Law Association
James P. Hume
38 S. Dearborn
Chicago 3, Illinois
Robert C. Brown, Jr.
George E. Frost
Its Attorneys

Chicago, Illinois
June 1, 1960